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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,305	09/29/2000	Neelakantan Sundaresan	AM9-99-0148	2611

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EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/672,305

**Applicant(s)**

SUNDARESAN, NEELAKANTAN

**Examiner**

Matthew s Gart

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-9 and 26-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9 and 26-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3625

### **DETAILED ACTION**

Claims 1-5, 7-9 and 26-34 are pending in the instant application. Claims 6 and 10-25 have been canceled.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-5, 7-9 and 26-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over icontact.com, as described in the articles:**

"Online Stories Hope Shoppers say Aye to Watchful Assistants" (Marriott, Michel. February 20, 2000. Sun Sentinel)(PTO-892, Ref U)

"Internet's First Online Salesperson Technology Offered by icontact.com, Inc." (Press Release. February 16, 2000)(PTO-892, Ref V)

Referring to claim 1. Icontact.com discloses a method for conducting electronic commerce, comprising:

- Browsing, by a user for an item at an electronic store over an electronic medium (Ref U, paragraph 1);

Art Unit: 3625

- Recognizing that the user is lost in attempting to find said item (Ref U, paragraph 2, "The shopper was looking for a hope chest at the site of a Boston-based store called Home Town Stores, but she was becoming frustrated (lost) as her searches persistently guided her to pages selling tool chests. Torres (store assistant) decided to step in."); and
- Interactively querying by an electronic store assistant at any time during a session, of said user whether the user needs help in finding said item (Ref U, paragraph 2, "Torres (store assistant) decided to step in.").

Icontact.com does not expressly disclose a method wherein said electronic store assistant is implemented in software as one of a program and a search window which is activated based on one of a query and activated automatically after a predetermined number of navigations by said user.

Instead, iconact.com comprises a real live "guide" who monitors the behavior of a customer and who decides when to intervene to aid his/her navigation of a web site. It was known at the time the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F. 2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). In both iconact.com and the instant invention a shopper is being directed towards a purchasing decision that better fulfills their shopping needs. Simply automating the step of detecting when the customer needs help gives just what one would expect from the manual step as shown in "Icontact.com." The provision of this

Art Unit: 3625

calculation via software, using any number of metrics – e.g. number of navigations, amount of time, or otherwise – provides no enhancement in the claimed step other than the known advantage of increased speed. The “guide’s” calculation of when to intervene in the customer’s navigation could easily be captured by a computer algorithm. The end result is the same as compared to the manual method.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the step of determining when to intervene to facilitate a customer, using software, because this would speed up the process that is known in the art.

Referring to claim 2. Icontact.com further discloses logging into a computer system by the user (Ref V, paragraph 2).

Referring to claim 3. Icontact.com further discloses a method wherein said browsing comprises navigating to through a hierarchy of categories (Ref U, paragraph 1).

Referring to claim 4. Icontact.com further discloses a method wherein said recognizing includes detecting by an e-Store assistant that the user is lost, said querying being performed by said e-store assistant (Ref U, paragraph 2).

Referring to claim 5. Icontact.com further discloses a method wherein said recognizing includes said user recognizing that the user is lost and said requested help from an e-Store assistant (Ref U, paragraph 8).

Art Unit: 3625

Referring to claim 7. Icontact.com further discloses a method wherein said e-Store assistant comprises a software dialer that dials up a telephone number of a customer support center (Ref U, paragraph 9).

Referring to claim 8. Icontact.com further discloses a method comprising:

- Considering the history of the browser based on a query that said user has typed in (Ref U, paragraph 2);
- Determining whether the user is lost (Ref U, paragraph 2); and
- Routing said user to a help resource to help the user (Ref U, paragraph 2).

Referring to claim 9. Icontact.com further discloses a method wherein said help resource comprises one of a live person and a chat program (Ref U, paragraph 2).

Referring to claims 26-34. Claims 26-34 are rejected under the same rationale as set forth above in claims 1-5 and 7-9.

### ***Response to Arguments***

Applicant's arguments with respect to claim 1-5, 7-9 and 26-34 have been considered but are moot in view of the new ground(s) of rejection.

The Attorney argues that the claimed invention does not merely automate a manual activity that accomplishes the same result. Instead, the claimed invention recites a unique combination of elements that accomplishes clearly different results, which are not, discloses or suggested by the method described by icontact.com.

The Examiner notes, page 1 of the specification of the instant invention discloses that the present invention relates to a system and method of electronic commerce and

Art Unit: 3625

more particularly to a system and method for bringing an electronic shopping experience closer to a traditional shopping experience by defining an electronic store assistant which helps electronic shoppers who are lost while browsing for an item in an electronic commerce site.

The Examiner further notes, this is expressly the result that is accomplished by icontact.com, whereby icontact.com allows e-commerce companies to replicate the proactive capabilities of a salesperson in a brick-and-mortar store. Icontact.com can proactively approach and assist a customer visiting a Web site just as a salesperson would when a customer enters a retail store.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3625

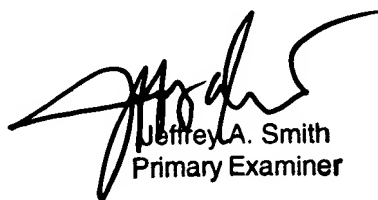
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew s Gart whose telephone number is 703-305-5355. The examiner can normally be reached on 8:30AM to 5:00PM m-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MSG  
August 16, 2004



Jeffrey A. Smith  
Primary Examiner